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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Kenichi NAKAMA, et al.

Docket No: Q58939

Appln. No. 09/529,990

Group Art Unit: 1762

Confirmation No.: 7259

Examiner: Alicia Ann Chevalier

Filed: April 24, 2000

For: MULTILAYER-COATED SUBSTRATE AND PROCESS FOR PRODUCING THE SAME

PETITION FOR REVIEW OF RESTRICTION REQUIREMENT

UNDER 37 C.F.R. § 1.144

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a petition for review and withdrawal of an improper restriction requirement.

A petition and payment for a one month extension of time extending the due date for response to Monday, August 19, 2002, and an Amendment under Rule 1.111, are being filed concurrently.

On February 7, 2002, the Office mailed an Office Action setting forth a restriction requirement in this National Phase application of a PCT application.

The Examiner required restriction as between two groups:

Group I, claims 1-12, drawn to a multilayer-coated substrate; and

Group II, claims 13-16, drawn to a process for producing a multilayer-coated substrate.

Applicants responded to the restriction requirement on March 7, 2002, electing Group I, claims 1-12, drawn to a multilayer-coated substrate. The election was with traverse.

The Examiner subsequently mailed an Action on the merits on April 18, 2002, in which the restriction requirement was made final. In the Action, the Examiner did not address or respond to the reasons Applicants provided in their traversal as to why the restriction requirement is improper.

Applicants submit that the requirement for restriction is improper and should be withdrawn.

In PCT applications such as the present application, restriction is proper only in the absence of "unity of invention." See 37 C.F.R. § 1.475. Rule 1.475(b)(1) expressly provides that a PCT application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to "A product and a process specially adapted for the manufacture of said product."

MPEP §1893.03(d) on unity of invention explains that:

> ...A process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression "specially adapted" does not imply that the product could not also be manufactured by a different process.

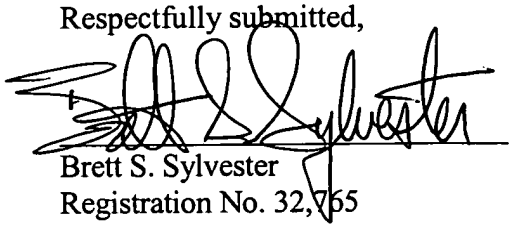
Here, claims 1-12 (Group I) are drawn to a product (a multilayer-coated substrate) and claims 13-16 (Group II) are drawn to a process specially adapted for the manufacture of the product (i.e., they are drawn to a process for producing the multilayer-coated substrate). The

process of the Group II claims inherently produces the claimed multilayer-coated substrate of the Group I claims. As seen in the MPEP quoted above, in PCT applications it is irrelevant whether the product can also be manufactured by a different process, which has not been shown in any event.

Further, Applicants disagree with the Examiner's assertion that evidence of lack of unity of invention between the two groups is found in Andrus '596. Here, the two groups of claims are drawn to a product and a process specially adapted for the manufacture of that product; thus, the two groups satisfy the "unity of invention" requirement. Whether the "features" of an individual claim are found in the prior art is irrelevant to the issue of unity of invention and the propriety of the restriction requirement. Further, Applicants do not agree that Andrus '596 discloses the features of instant claim 1, although it is not believed necessary to address the issue of patentability on the merits in the present petition. Patentability over Andrus '596 is discussed in the Amendment Under 37 C.F.R. § 1.111 filed concurrently.

For the above reasons, Applicants respectfully submit that the requirement for restriction should be reconsidered and withdrawn.

Respectfully submitted,



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